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Dated: 2/28/05

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(Ginny Brundell)

Docket No.: WIBL-P01-010
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Sabatini et al.

Application No.: 10/782244

Confirmation No.: 5817

Filed: February 18, 2004

Art Unit: 1653

For: mTOR KINASE-ASSOCIATED PROTEINS

Examiner: Rooke, Agnes B.

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO RESTRICTION REQUIREMENT

Sir:

This reply is being filed in response to the outstanding Office Action mailed December 28, 2004, in connection with the above application. A petition for a one-month extension of time and appropriate fees are being filed concurrently herewith.

Applicants hereby elect, with traverse, Group III (Claims 8-21 and 31-33), drawn to nucleic acid, vector, host cell, method of making protein, and a kit comprising the nucleic acid. Applicants traverse the restriction requirement for the reasons which follow.

Applicants particularly request rejoinder of claims 28-30 of Group V, drawn to a method of detecting the nucleic acid. Applicants note that Group V shares a common technical feature with Group III, namely the subject nucleic acid, which would facilitate searching these groups at once. Indeed, Applicants note that both Groups III and V are classified in class 435.

Pursuant to MPEP §803, "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions." Applicants submit that simultaneous examination of Groups III and V will not impose a substantial additional burden on the

Examiner. Accordingly, Applicants respectfully request that the restriction requirement be withdrawn.

To the extent that the Examiner requires Applicants to elect one nucleotide sequence from Group III, Applicants hereby elect SEQ ID NO: 2 for search purposes only. Applicants submit that the various sequences subject to election requirement are encompassed by a Markush group. Pursuant to MPEP 803.02, “[i]f the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the examiner must examine all claims on the merits, even though they are directed to independent and distinct inventions.” In addition, Applicants respectfully point out that the search of the Markush-type claim will be extended to non-elected species should no prior art be found that anticipates or renders obvious the elected species (MPEP 803.02). In this case, it is Applicants’ position that the members of the Markush group are “sufficiently few in number” and may be searched and examined without a serious burden on the office.

Furthermore, Applicants note that MPEP § 803.04 states that “to further aid the biotechnology industry in protecting its intellectual property without creating an undue burden on the Office, the Commissioner has decided *sua sponte* to partially waive the requirements of 37 C.F.R. 1.141 *et seq.* and permit a reasonable number of such nucleotide sequences to be claimed in a single application.” The MPEP goes on to state that “it has been determined that normally ten sequences constitute a reasonable number for examination purposes.” Once again, Applicants submit that the present claims include fewer than 10 sequences and as such constitute a reasonable number of sequences for search and examination.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the sequence election requirement and request a search and examination of both SEQ ID NO: 2 and SEQ ID NO: 5 as claimed herein.

CONCLUSION

The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Applicants are filing concurrently herewith a petition for extension of time.